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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,363	05/01/2000	JEAN GABERT	1721-21	5387

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EXAMINER

STRZELECKA, TERESA E

ART UNIT PAPER NUMBER

1637

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/530,363

Applicant(s)

GABERT, JEAN

Examiner

Teresa E Strzelecka

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 08 October 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 43-57,59,61 and 62.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s): _____

10. ☐ Other: _____

TS 1/7/05


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Continuation of 3. Applicant's reply has overcome the following rejection(s): rejection of claims 43-62 under 35 U.S.C. 112, first paragraph, rejection of claims 43-62 under 35 U.S.C. 112, second paragraph and rejections of claims 58 and 60 under 35 U.S.C. 102(e) as anticipated by Morris et al.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues that claim 61 was indicated as allowable over Morris et al., however, claims 59 and 61 were rejected over Morris et al. and Holtke et al., in view of Stratagene catalog, therefore, since the limitations of claim 58 were included in claim 61, claim 61 remains rejected. Regarding the rejection of claims 43-48 and 57 under 35 U.S.C. 103(a) over Nisson et al. and Holtke et al, rejection of claims 49-54 under 35 U.S.C. 103(a) over Nisson et al. and Holtke et al. in view of Felix et al., rejection of claims 55 and 56 under 35 U.S.C. 103(a) over Nisson et al., Holtke et al., Felix et al. and Kaneko et al., and the rejection of claim 62 over Nisson et al., Holtke et al., Felix et al. and Statagene catalog, Applicant argues that Nisson et al. fails to teach detection of detectably labeled cDNA or incorporation of a detectable label. However, this argument analyzes references separately, whereas it is the Holtke et al. reference which provides both the teaching and the motivation to incorporate a detectable label into the amplification product, making the claims obvious over the given combination of references. Therefore the rejections are maintained.